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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,559	02/09/2001	Richard Levy	01064.0011-06000	9094

7590 03/25/2004
The Law Offices of Robert J. Eichelburg
Hodafel Building
Suite 200
196b Acton Road
Annapolis, MD 21403

EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,559

Applicant(s)

LEVY, RICHARD

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003 and 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

The amendment of July 8, 2003, has been entered.

Allowable Subject Matter

The indicated allowability of claims 57-77 is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iri et al, 4,711,523 (Iri), or Freeman, 5,218,011 each in view of Marciano-Agostinelli et al, 5,049,593 (Marciano-Agostinelli).

Iri teaches a waterproof optical fiber cable and a method of protecting a substrate from the affects of water or water migration, comprising a water blocking material and an optical fiber disposed inside the water blocking material, presumably resulting in a substrate coated with said water blocking layer, per claims 57, 63-64, 67, and 73-75. See abstract. Said water blocking material is essentially water-free and comprises grease and a superabsorbent polymer such as acrylic acid polymer as contemplated by applicants in claims 57, 58-62, and 67-72. See column 2, line 18 through column 4, and line 13. As to claims 65 and 66, these claims are product-by-process claims. Even

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though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production.

Freeman teaches an essentially water-free gel composition and method for protecting a substrate such as wires and cables from damage by water, said gel composition comprising a gel matrix and a water absorbent polymer, as required by claims 57, 63-64, 67, and 73-75. See abstract. In addition, Freeman teaches that the superabsorbent polymer can be based on acrylamides, acrylates and acrylic acid, as required by claims 59-60, and 69-70, and that his gel matrix can be a petroleum lubricant, grease or synthetic lubricant, of the type contemplated by applicants in claims 57-58, 61-62, 67-68, and 71-72. See column 7, line 19 through column 8, and line 44. As to claims 65 and 66, these claims are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production.

Neither Iri nor Freeman teach the amount of absorption of the superabsorbent particles.

Marciano-Agostinelli teaches a water migration resisting filler comprising a polymeric compound and particles of a water swellable material that is applied to stranded wires of a cable. See abstract. The particles are of the type contemplated by applicants in claims 59-60 and 69-70, such as acrylamides and acrylates and have a

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water absorbing capability of 100 times its weight in water, as required by applicants in claims 57 and 67. See column 5, lines 43-62.

Though Iri and Freeman are silent as to the water absorbing capability of their particles, it is the examiner's position that this property necessarily is the same as that contemplated by applicants and is inherent. Marciano-Agostinelli teaches particles of the same type contemplated by applicants and as taught by Iri and Freeman. The skilled artisan would reasonably presume that the same particles necessarily have the same properties, in the absence of factual evidence to the contrary.

Therefore, the combined teachings of Iri and Marciano-Agostinelli or Freeman and Marciano-Agostinelli would have rendered obvious the invention as claimed in the present claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Each of the cited references teach essentially water-free compositions applied to a substrate, wherein said composition comprises a grease, synthetic lubricant or petroleum lubricant and a superabsorbent polymer. Applicants have not clearly defined that which they regard as their invention.

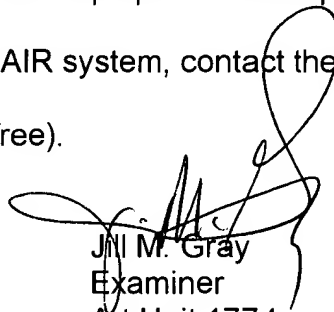
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray
Examiner
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jmg